

Remarks

Claim 1 is amended to fix the term "internet" in the claim to the term "Internet", as suggested by the Examiner.

Claim 5 is amended to add the term "the" before "caller ID information", as suggested by the Examiner.

New Claims 13, 16, and 18 are added to the application, in response to a phone call made by the Examiner indicating possible allowable subject matter. Support for these amendments is found in the specification on page 8, line 1 to page 9, line 10 of the application.

New Claims 14-15, 17, and 19-20 are added to differentiate that the first connection made through a PSTN and the second claimed connection are different connections. Support for these amendments are found in the specification on page 7, lines 16-25 (where in response to information, the client device calls up an ISP, which needs to be done through a second separate and different connection from the first PSTN connection).

No new matter was added in view of these amendments.

I. 35 U.S.C. 102(e) Rejection of Claims 1-5 and 7-12

The Examiner rejected Claims 1-5 and 7-12 under 35 U.S.C. 102(e) as being anticipated by Oyama et al. (U.S. Patent # 6,108,329, hereafter referred to as 'Oyama'). Applicants disagree with this ground of rejection.

Claim 1 claims the following elements:

"determining whether the called device is already connected to the Internet" and

"initiating a PSTN telephone call with associated caller ID information to the called device, if the called device is not already connected to the internet".

These claimed steps are neither disclosed nor suggested in Oyama.

In response to these arguments the Examiner writes in the Office Action that "Herein, the server 21 already determined that the terminal T21 is not already connected to the server, otherwise, the server would not dial the Terminal T21)" (see Office Action, page 3, fourth paragraph).

The Examiner still does not point out however where in Oyama how the server performs (has already determined) the claimed operation of, "determining whether the called device is already connected to the Internet". That is, Applicants are unaware in Oyama how such an operation is performed, nor does the Examiner show where such a step is recited.

In fact, the Oyama reference implies that it is assumed that in many cases that a user to be contacted is disconnected from a network, "The internet requires an IP address to specify a destination terminal. In this case, the destination terminal T2 to be connected by PPP is normally disconnected from the computer network NET1, and cannot be accessed to through an IP address. Therefore, the data base DB1 is used," (Oyama, col. 5, lines 6-11). That is, Oyama performs its steps without determining whether a user is connected or disconnected from a network (unlike what is claimed in Claim 1).

As required under 35 U.S.C. 102(e), in order to sustain a rejection, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)". Applicants submit that the Examiner has not made a prima facie case under 102(e), in showing where the Oyama reference discloses "determining whether the called device is already connected to the Internet".

In addition, Applicants assert that Oyama neither discloses nor suggests the use of two connections in the establishment of an Internet voice call. Specifically, Oyama discloses that a server S1 which calls a destination terminal T2 to establish a PPP based connection (Oyama, col. 5, lines 35-41, col. 7, lines 3-6). T2 then connects to the Server (S1) forming only one connection. In contrast, once a called device is called over a PSTN (forming one connection) which reveals called ID information to the called device, the called device will initiate a second connection as to establish an Internet voice call.

The use of two separate and therefore different connections, as distinguished in Claims 14 and 15, is not disclosed or suggested in Oyama. The ability to establish a second data connection (which is different and separate from the first connection) provides the called device flexibility in terms of how to connect to the Internet. The teachings of Oyama only provide one way for a called device to connect to the Internet, by picking up the telephone call made over the PSTN by a server S1 (see Oyama col. 5, lines 31-41, col. 7, lines 19-26, and col. 9, lines 3-25).